In the second enumerated paragraph of the Office Action, the Examiner objected to the specification for various informalities. In response, Applicant has amended the specification per Examiner's suggestion.

Claims 1-3 and 6-10 are rejected under 35 U.S.C. § 102(b) for lack of novelty as evidenced by admitted prior art of Figures 8-19B (hereinafter the Admitted Prior Art)

In the fourth enumerated paragraph of the Office Action, the Examiner asserted that the Admitted Prior Art discloses a semiconductor test apparatus corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that one having ordinary skill in the art would have recognized that the identically claimed invention is within the public domain.[1] Furthermore, the Examiner must also establish that the applied reference identically discloses *each* feature of the claimed invention.[2] As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.[3]

[1] ATD Corporation v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998); Electro Medical Systems S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).
[2] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).
[3] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

Independent claims 1 and 10 have both been amended to clarify that each mount position on a reinforcement member is provided with a counterbore of substantially the same depth and shape (see page 3, lines 19-21). In contrast, as clearly stated on page 3, lines 28-32 of Applicant's disclosure with regard to the Admitted Prior Art:

> Counterbores 13a to be used for attaching the screws 17 are formed in two attachment arms 13A and 13C from among four attachment arms 13A through 13D of the reinforcement member 13. In contrast, no counterbores 13a are formed in the remaining two attachment arms 13B and 13D.

As no counterbores are formed in two of the mount positions of the Admitted Prior Art, the Admitted Prior Art cannot identically disclose that each mount position on a reinforcement member is provided with a counterbore of substantially the same depth and shape. Thus, there are significant differences between the Admitted Prior Art and the invention defined in amended claims 1 and 10 that would preclude a factual determination that the Admitted Prior Art identically describes the claimed invention within the meaning of 35 U.S.C. § 102.

With regard to claims 2 and 3, the Examiner referred to Fig. 15 and stated that the Admitted Prior Art discloses using screws having the same length and type. A review of the specification does not yield such a teaching. Instead, on page 4, lines 18-25, the Admitted Prior Art discusses the use of two types and lengths of screws. Furthermore, if the Examiner relied solely on Fig. 15, Applicant refers the Examiner to M.P.E.P. § 2125, which states "PROPORTION OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE" (capitalization in original). As the Admitted Prior Art fails to state that the drawings are to scale, "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if

the specification is completely silent on the issue."[4] Therefore, Fig. 15 cannot be relied upon to disclose screws having the same length and/or type.

With regard to claim 7, the Examiner has failed to establish that the Admitted Prior Art teaches a center section that has a thickness greater than a peripheral section that includes the plurality of mount positions, as the Examiner has failed to clearly designate the teachings in the Admitted Prior Art being relied upon by the Examiner. In this regard, the Examiner's rejection also fails to comport to the provisions of 37 C.F.R. § 1.104(c).[5]

The Examiner's rejection as to claims 8 and 9 also fails to clearly designate the teachings in the Admitted Prior Art being relied upon by the Examiner for teaching a frame-shaped center section (claim 8) or a reinforcement member and a probe card substrate being fastened to each other in a center section (claim 9).

The above argued differences between the semiconductor element test apparatus defined in claims 1-3 and 6-10 and the test apparatus of the Admitted Prior Art undermine the factual determination that the Admitted Prior Art identically describes the claimed invention within the meaning of 35 U.S.C. § 102.[6] Applicant, therefore, respectfully submits that the imposed rejection

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[4] See, Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000).

[5] 37 C.F.R. § 1.104(c) provides:

> In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

[6] Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

of claims 1-3 and 6-10 under 35 U.S.C. § 102 for lack of novelty as evidenced by the Admitted Prior Art is not factually viable and, hence, solicit withdrawal thereof.

Claims 4 and 5 are rejected under 35 U.S.C. § 103 for obviousness predicated upon the Admitted Prior Art

In the sixth enumerated paragraph of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the test apparatus of the Admitted Prior Art to arrive at the claimed invention. This rejection is respectfully traversed.

The Examiner cited In re Dailey[7] for the proposition that a change in shape is generally recognized as being within the level of ordinary skill in the art. This case is cited in M.P.E.P. § 2144.04 under the heading of "Changes in Shape." The Examiner, however, has apparently ignored the following language also found under the heading of "Changes in Shape":

> The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant. (emphasis added)

In this regard, the Examiner is referred to the second full paragraph on page 10 of Applicant's disclosure, which discusses the significance of the round-head screws having bulging screw heads recited in claim 4. Therefore, the Examiner's citation of In re Dailey is inappropriate in establishing a prima facie basis of obviousness for rejecting claim 4.

With regard to claim 5, the Examiner cited In re Seid[8] for the proposition that an aesthetic design change is generally recognized as being with the level of ordinary skill in the art. As with In

[7] 357 F.2d 669, 149 USPQ 47 (CCPA 1966).
[8] 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

re Dailey, the Examiner apparently found In re Seid in M.P.E.P. § 2144.04. The Examiner, however, has completely ignored the warning in the first paragraph of M.P.E.P. § 2144.04, which states:

> if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

The facts of In re Seid involve a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle. The court found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. As pertaining to claim 5 of the present invention, the Examiner has argued that a magnetic substance is merely aesthetic. Such an assertion by the Examiner, however, is without basis, as a magnetic substance provides a mechanical function (i.e., to attract magnetic materials). Therefore, the Examiner's citation of In re Seid is inappropriate in establishing a prima facie basis of obviousness for rejecting claim 5. Thus, Applicant respectfully submits that the imposed rejection of claims 4 and 5 under 35 U.S.C. § 103 for obviousness predicated upon the Admitted Prior Art is not viable and, hence, solicits withdrawal thereof.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

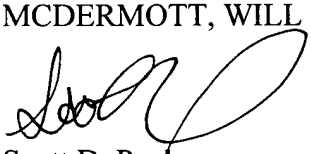
Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Scott D. Paul
Registration No. 42,984

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS:SDP:ejb
Date: March 4, 2003
Facsimile: (202) 756-8087

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The specification has been amended as follows:

Page 2, first full paragraph, please delete in its entirety and replace with the following:

--Fig. 11 is a side view showing the constitution of the prober 2 while the stage 4 remains in a lowered position. Fig. 12 is a perspective view showing a probe [guard] card 1 having the probe needles 7 mounted thereon. Fig. 13 is a top view showing the probe [guard] card 1. The prober 2 is equipped with the probe [guard] card 1. The probe [guard] card 1 has a probe card substrate 12 which supports the plurality of probe needles 7. The prober 2 has a test head 10 which operates in cooperation with the probe card 12. A plurality of probe needles 7 are supported on the lower surface of the probe card substrate 12, and on the top of the probe card substrate 12 are provided a reinforcement member 13 for reinforcing the probe card substrate 12, and a plurality of ZIF connectors 11. A plurality of ZIF sockets 9 corresponding to ZIF connectors 11 are provided on the lower surface of the test head 10. The semiconductor elements 6 exchange a test input signal and test output signals with the tester 3, by means of the ZIF connectors 11 being coupled to the ZIF sockets 9. The ZIF sockets 9 incorporate springs and are connected to the ZIF connectors 11 by means of meshing action.--

IN THE CLAIMS:

Claims 1, 8 and 10 have been amended as follows:

1. (Amended) A semiconductor element test apparatus comprising:

a stage on which a semiconductor wafer having semiconductor elements is to be mounted;

a probe card having a plurality of probe needles opposing the semiconductor wafer; and

a probe card hold member for holding test probe card; and

the semiconductor elements are tested by bring the plurality of probe needles into contact with the semiconductor elements of the semiconductor wafer, wherein

the probe card has a probe card substrate for supporting the plurality of probe needles and a reinforcement member for reinforcing the probe card substrate, and the reinforcement member has a plurality of mount positions and counterbores of substantially the same depth and shape in [a] each of the plurality of mount positions; and

the probe card substrate is attached to the probe card hold member through the reinforcement member at the counterbores by screws.

8. (Amended) [The] A semiconductor element test apparatus [according to claim 1] comprising:

a stage on which a semiconductor wafer having semiconductor elements is to be mounted;

a probe card having a plurality of probe needles opposing the semiconductor wafer; and

a probe card hold member for holding test probe card; and

the semiconductor elements are tested by bring the plurality of probe needles into contact with the semiconductor elements of the semiconductor wafer, wherein

the probe card has a probe card substrate for supporting the plurality of probe needles and a reinforcement member for reinforcing the probe card substrate, and the reinforcement member has counterbores of substantially the same depth and shape in a plurality of mount positions;

the reinforcement member comprises a peripheral section having a plurality of reinforcement arms, each reinforcement arm having the mount position, and a frame-shaped center section, and a reinforcement piece for two interconnecting mutually-opposing sides of the frame-shaped center section is provided in the center section; and

the probe card substrate is attached to the probe card hold member through the reinforcement member at the counterbores by screws.

10. (Amended) A method of testing a semiconductor element through use of a semiconductor test apparatus which brings a plurality of probe needles provided on a probe card into contact with semiconductor elements of a semiconductor wafer, wherein

the probe card has a probe card substrate for supporting the plurality of probe needles, and a reinforcement member to be used with the probe card substrate;

the semiconductor element test apparatus has a probe card hold member having the probe card attached thereto;

the reinforcement member is attached to the probe card substrate and to the probe card hold member at a plurality of mount positions by means of screws;

counterbores of substantially the same depth and shape are formed in each of the respective mount positions on the reinforcement member; and

the probe card substrate is attached to the probe card hold member by means of the screws and by way of the counterbores.